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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/992,902	11/14/2001	Paul John Zuraw	CHR 00-77	5676

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EXAMINER

PIAZZA CORCORAN, GLADYS JOSEFINA

ART UNIT	PAPER NUMBER
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1733

DATE MAILED: 01/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/992,902

Applicant(s)

ZURAW ET AL.

Examiner

Gladys JP Corcoran

Art Unit

1733

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 22 December 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☒ They raise the issue of new matter (see NOTE below);
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-7.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☐ Other: _____.


Gladys JP Corcoran
Primary Examiner
Art Unit: 1733

Continuation of 3. NOTE:

The amendment to claim 1 changing the transitional phrase of "comprises" to "consists essentially of" raises new issues that would require further search, consideration and raises the issue of new matter.

Continuation of 11. does NOT place the application in condition for allowance because:

It is noted that the amendment to claim 1 deleting "resin saturable" and inserting "saturating kraft" would be entered if filed in a separate amendment and would overcome the 35 USC 112 rejection in paragraphs 1 and 2 of the prior Office Action filed November 22, 2005, for purposes of Appeal only.

Applicant argues on page 4 that the Examiner does not address that Hagen teaches a sequence of steps where the paper web is first sized and then is impregnated throughout with a thermosetting synthetic resin" (col. 4, lines 29-39). These steps are not addressed because the column and lines referred to clearly state and alternative embodiment not required. The passage begins with "An alternative method of preparing a separator sheet". Therefore, these are not required steps and are not the disclosed method relied upon for the basis of rejecting the claims. There is no suggestion to one of ordinary skill in the art that the alternative method must be performed and is the only way of forming the separator sheets.

Applicant argues on page 5 that additional references to Jaisle I and II state that only by incorporating a phenolic reference resin was Hagen able to produce a satisfactory release sheet." Neither of these references are relied upon for the rejection of the claims. Such statements in the Jaisle references do not discount the teachings of Hagen of forming a separator sheet. The steps of adding a resin in Hagen was taught as an Alternative Embodiment only and there is nothing to suggest to one of ordinary skill in the art that the alternative embodiment includes required steps.

Applicant argues on page 5 that the claim has been amended to recite "consists essentially of" and therefore the teaching of Hagen in col. 4, lines 29-39 can not be ignored. These amendments are not being entered as discussed above. However, it is noted that the teaching in Hagen at col. 4, lines 29-39 is an alternative embodiment including additional steps not required.

Applicant incorrectly argues that the secondary reference of Bradner is relied on merely as prior art suggestion for the claim limitations in dependent claim 2. The independent claim 1 is rejected over Hagen in view of Bradner where Bradner is an example of the well known concept in the paper coating arts to provide a sizing coating on-machine as an alternative to post machine coating in order to reduce time, labor and capital investment. Applicant does not provide an argument to the rejection in this response.